

REMARKS

In a final office action (herein called "the Final Office Action") dated September 11, 2003, claims 1, 4, 6, 9, 18, 19, 21 and 22-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Elabd in view of Baker; and claims 3, 5, 8, 10 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Elabd, Baker and Yanai. These rejections are discussed below.

All of the § 103 rejections are based on the modification of Elabd in view of Baker. "Obviousness cannot be predicated on what is unknown." *In re Spormann*, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966). Thus, to establish a *prima facie* case of obviousness, the Examiner must support, with specific citations to the prior art, where the prior art contains the alleged suggestion or motivation for the modification of Elabd to derive the claimed invention. See *Ex parte Gambogi*, 62 USPQ2d 1209, 1212 (Bd. Pat. App. & Int. 2001); *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); M.P.E.P. § 2143. However, as set forth below, the Examiner fails show such a suggestion or motivation, as the Examiner's conclusion of obviousness assumes knowledge of the claimed invention.

In the Final Office Action, the Examiner refers to lines 46-52 in column 9 of Baker. This cited passage refers to the advantage of having two capacitors for integration, in that while light is being integrated via one capacitor, a stored integrated value may be read out from the other capacitor. The Examiner contends that this language is the alleged suggestion or motivation that would have led one skilled in the art to modify Elabd so that light is integrated directly into the storage registers 454, thereby bypassing the integration storage elements of the image register 452. However, the cited language does not support this conclusion. Rather, the cited language would, at most, have motivated one skilled in the art to include multiple integrating capacitors in Elabd's image register 452 for each pixel. Thus, by including multiple integration capacitors in the image register 452, this would reduce any delay between integrations by the image register 452, as taught by Baker, in that one capacitor of the image register 452 may be integrating while another capacitor furnishes a previously integrated value. However, without the hindsight gained by knowledge of the claimed invention, one skilled in the art would not have been motivated to modify Elabd so that Elabd's integration bypasses any storage element in the image register 452 and instead, relies on storage elements of the memory 454 as the integrating elements. Thus, the

Examiner merely concludes such a motivation or suggestion exists, without showing where the prior art contains such a suggestion or motivation.

Therefore, the Examiner fails to show where the prior art contains a suggestion or motivation to modify Elabd to derive the claimed invention. In other words, the Examiner fails to show where the prior art contains the alleged suggestion or motivation to modify Elabd so that storage locations in which integration occurs are designated for different primary color components, and therefore, fails to establish a *prima facie* case of obviousness for either independent claim 1, 6, 18 or 22. Claims 3-5, 8-10, 19-21 and 23-28 are patentable for at least the reason that these claims depend from allowable independent claims.

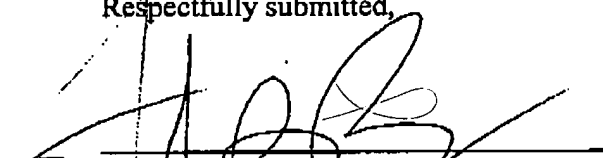
#### CONCLUSION

In view of the foregoing, withdrawal of the § 103 rejections and a favorable action in the form of a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (ITL.0061US).

Date:

10/24/03

Respectfully submitted,

  
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